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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,700	01/18/2002	Hans-Werner Schmidt	1-22531/US/AO/UBT2/PCT	1004

324 7590 04/22/2004

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PATENT DEPARTMENT  
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TARRYTOWN, NY 10591-9005

EXAMINER

SANDERS, KRIELLION ANTIONETTE

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/914,700

Applicant(s)

SCHMIDT ET AL.

eb8

Examin r

Kriellion A. Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-10 & 12 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☒ Interview Summary (PTO-413) (2)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-9 and 12, drawn to a polymeric composition.

Group II, claim(s) 10, drawn to compounds.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The compounds of Group II may be used in a technically different manner than as the non-reactant additives of the Group I compositions. For example, the compounds of Group II may be used as a reactant component in the production of a synthetic resin.

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species defined by the compound of formula 1 wherein:

A may be carbon, nitrogen, phosphorous, boron and silicon

B may be esters, thioesters, ethers, thioethers, ketones, secondary amines, tertiary amines, amides, imides, imines, azo, azoxy, urea, urethane, thiourethane, sulfonamide, mixtures of the above

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B' may be carboxylic acid, sulfonic acid, alcohol, phenol, thiol, amine, acetamide, cyano, hydrazide

X may be hydrogen; alkyl; alkenyl; alkoxy; alkanoy;, alkylthio; alkylthioalkyl; alkylaryl; arylalkyl; alkylsulfinyl; alkoxyalkyl; alkylsulfonyl; alkoxycarbonyl; carboxylic acid; alkyl substituted with one or more of sulfonic acid, carboxylic acid, halogen, nitro, cyano, diazo, epoxy; aromatic ring compounds which may be substituted with nitrogen, sulfur, sulfonyl, sulfonyl, oxygen; aliphatic ring compounds which may be substituted with nitrogen, sulfur, sulfonyl, sulfonyl, oxygen

X' may be hydrogen; alkyl; alkenyl; alkoxy; alkanoy;, alkylthio; alkylthioalkyl; alkylaryl; arylalkyl; alkylsulfinyl; alkoxyalkyl; alkylsulfonyl; alkoxycarbonyl; carboxylic acid; alkyl substituted with one or more of sulfonic acid, carboxylic acid, halogen, nitro, cyano, diazo, epoxy; aromatic ring compounds which may be substituted with nitrogen, sulfur, sulfonyl, sulfonyl, oxygen; aliphatic ring compounds which may be substituted with nitrogen, sulfur, sulfonyl, sulfonyl, oxygen

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP

§ 809.02(a).

4. The claims are deemed to correspond to the species listed above in the following manner:

The following claim(s) are generic: 1-9 and 12.

5. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The possible moieties described by substituents A, B, B', X and X' possess divergent functionalities and therefore different properties.

hydrogen; alkyl; alkenyl; alkoxy; alkanoyl; alkylthio; alkylthioalkyl; alkylaryl; arylalkyl; alkylsulfinyl; alkoxyalkyl; alkylsulfonyl; alkoxycarbonyl; carboxylic acid; alkyl substituted with one or more of sulfonic acid, carboxylic acid, halogen, nitro, cyano, diazo, epoxy; aromatic ring compounds which may be substituted with nitrogen, sulfur, sulfonyl, sulfonyl, oxygen; aliphatic ring compounds which may be substituted with nitrogen, sulfur, sulfonyl, sulfonyl, oxygen

6. During a telephone conversation with Tyler Stevenson on 1/27/2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-9 and 12.

Affirmation of this election must be made by applicant in replying to this Office action. Claim 10 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. A subsequent telephone call was made to Tyler Stevenson on or around 4/6/2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

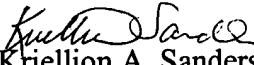
8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 6:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kriellion A. Sanders  
Primary Examiner  
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